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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
1740-000038/US

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On _____

Signature _____

Typed or printed name _____

Application Number
10/789,992Filed
March 2, 2004First Named Inventor
Sang Woon SUH et al.Art Unit
2627Examiner
Thomas Alunkal

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,416.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Gary D. Yacura

Typed or printed name

(703)668-8000

Telephone number

October 22, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sang Woon SUH et al. Confirmation No.: 9678
Application No.: 10/789,992 Examiner: Thomas Alunkal
Filing Date: March 2, 2004 Group Art Unit: 2627
Title: RECORDING MEDIUM WITH RESTRICTED PLAYBACK
FEATURE AND APPARATUS AND METHODS FOR FORMING,
RECORDING, AND REPRODUCING THE RECORDING MEDIUM
Attorney Docket: 1740-000038/US

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Randolph Building
401 Dulany Street
Alexandria, VA 22314
Mail Stop AF

October 22, 2010

REASONS FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

In response to the Final Office Action mailed on June 23, 2010 ("Final Office Action") and the Advisory Action mailed on September 14, 2010 ("Advisory Action"), Applicant requests that the Pre-Appeal Brief Review Board (hereinafter Board) review the pending rejections. The Pre-Appeal Brief Request and Notice of Appeal are being filed concurrently with these Reasons for Pre-Appeal Brief Conference.

Claims 1, 5-8, 10-11, 13, 15, 17-20, 22-24 and 41-51 are currently pending in this application. Claims 1, 13, 20, 42, and 49 are independent.

Claims 1, 5, 6, 8, 10, 13, 15, 17, 19, 20, 22, 42, 43, 47 and 50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sako (WO 02/37493) in view of Ha (USP 7,028,011).

Applicants respectfully traverse this rejection.

Initially, please see Applicant's arguments of record on pages 10-11 of the March 15, 2010 Amendment. Furthermore, please see Applicant's arguments of record on pages 10-11 of the August 23, 2010 Reply After Final.

In response to the arguments in the August 23, 2010 Reply After Final, the Examiner contends on page 2 of the Advisory Action:

The crux of the applicant's argument is that the "disc identifier" of Ha fails to identify a particular disc, but rather is used for authentication/copy protection. However, Column 7, lines 17-43 of Ha disclose that "disc identifier" is used to discriminate a type of optical disc from a blank disc. Therefore, the "disc identifier" of Ha does identify a particular disc type. Thus, the combined teachings of Sako in view of Ha disclose the claimed limitations of independent claim 1.

Applicants disagree. The crux of Applicant's argument was that the so-called disk identifier data of Ha and the disk ID information of Sako are not the same information. One skilled in the art would not take the teachings in Ha of where to store authentication/copy protection information (Ha's "disc identifier") and apply that to storing single/double density and recording form information (Sako's "disc identifier"). While Sako and Ha use similar "disk identifier" terminology, that terminology applies to very different information having totally different purposes. As such, it is improper to contend that the placement of one type of information on a recording medium would inform one skilled in the art as to the placement of completely different information.

The Examiner cites to Column 7, lines 17-43 of Ha as teaching that the disc identifier in Ha is used to discriminate a type of optical disc. However, this passage teaches using the disc identifier as a copy protection mechanism consistent with Applicant's assertions.

Accordingly, one skilled in the art would not have combined the teachings of Ha with Sako as asserted in the Office Action. In view of the above, even assuming Ha

was combined with Sako, the resulting combination fails to render claim 1 obvious to one skilled in the art.

Independent claims 13, 20 and 42 include similar limitations to those discussed above with respect to claim 1, and are patentable at least for the reasons stated above with respect to claim 1.

The remaining claims are patentable at least for depending on one of the above-discussed independent claims.

Applicants respectfully request that the Examiner withdraw this rejection.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to the claims as stated above, and further in view of Kuroda ('844). And, claims 11, 18, 23, 24, 41, 44-46, and 48 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims as stated above, and further in view of Official Notice.

Applicants respectfully traverse these 103 rejections. Applicants submit that these rejected dependent claims are allowable at least for depending from allowable base claims. In addition, Applicants submit that none of the cited references cure the deficiencies identified above with reference to Sako in view of Ha. Furthermore, while Applicants have not discussed the Examiner's Official Notice, that lack of discussion should not be construed as acquiescence by the Applicants.

Claims 49 and 51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sako in view of Horimai (USP 5,563,872) and further in view of Ha.

Applicants respectfully traverse this rejection.

Initially, please see Applicant's arguments of record on pages 12-14 of the March 15, 2010 Amendment. Furthermore, please see Applicant's arguments of record on pages 12-13 of the August 23, 2010 Reply After Final.

In response to the arguments in the August 23, 2010 Reply After Final, the Examiner contends on page 2 of the Advisory Action:

Specifically, the type of disc disclosed in Horimai is a CD (Column 9, lines 29-43). Therefore, the disc as disclosed by Horimai complies with the CD standard. As disclosed in Figure 5a of Horimai, wobbled pits are deflected by an amount so as to not overlap with a central line of the wobbled pits while still complying with the CD standard. Thus, when the teachings of Horimai are combined with the teachings of Sako, a wobbled pit string results that can be detected accurately by a single optical beam. The combined teachings of Sako in view of Horimai and further in view of Ha disclose the claimed limitation of independent 49.

The Examiner cites column 9, lines 29-43 of Horimai. This portion of Horimai does not mention anything regarding compact discs themselves. Instead, at best, Horimai seems to teach that the optical pickup may be the same structure as used for a compact disc and that if the diameter of the laser beam on the recording surface is set similar to that for a conventional compact disc, then the pits will have a certain width. Accordingly, Applicant's maintain their assertion that Horimai, like Sako, fails to disclose or suggest "at least a part of the wobbled pits forming the physical mark information wobble in a non-overlapping manner with respect to a central line of the wobbled pits," as recited in independent claim 49.

Sako in view of Horimai fails to render claim 49 obvious to one skilled in the art.

Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

CONCLUSION

In view of the above, Applicants respectfully request that the Conference consider and reverse the current rejections and either allow the present application or reopen prosecution in connection with the present application.

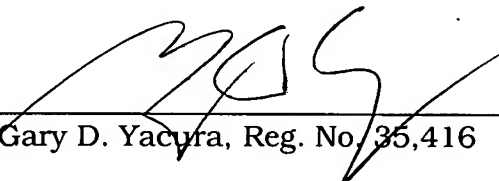
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By



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